

Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-16 and 18-23 are pending, with claims 1, 20, and 23 being the independent claims. Claims 1, 20 and 23 are sought to be amended for clarity. Applicants reserve the right to prosecute similar or broader claims, with respect to the cancelled and amended claims, in the future. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendments and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding rejections and that they be withdrawn.

Rejections under 35 U.S.C. § 103

In the Office Action the Examiner rejected claims 1-15 and 18 - 23 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,790,785 to Klug et al. ("Klug") in view of U.S. Patent No. 7,155,739 to Bari et al. (Bari"). Applicants respectfully traverse.

Claim 1

A. Klug Does Not Teach or Suggest Using Instructions to Detect, on the First Application, an Indication that the Customer is an Existing Account Holder

Claim 1 recites features that distinguish over the applied references.

For example, claim 1 recites, in part, using "instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder."

The Examiner, on page 8 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 9, lines 14-28 of Klug. The referenced portion of Klug discloses a system whereby “***after registering*** at the registrar web site 100, in step 432, the user is automatically placed in contact with the present third party web so that ***he/she submits a registration fill-out form*** to this third party web site 116: (a) indicating that the user’s registration information may be obtained from the registrar web site 100; and (b) providing a user ID (and optionally a password) for the registrar web site 100 to be used as identification at the present third party web site.” (See Klug, col. 9, ll. 14-22)(emphasis added). Thus, Klug discloses a system where the user first registers at the registrar web site, and then secondly is directed to a second web site (i.e., a third party web site) where the user again fills out another registration form, this time from the third party web site. The second registration process at the third party web site includes providing a user ID to the third party web site that identifies the user as a registered user of the registrar web site. Therefore, the third party web site is informed that the user is a registered user of the registrar web site by the user indicating such a status when the user is filling out the second registration form on the third party web site.

Applicants assert that Klug does not teach or suggest, based on the disclosed indication by the user on the second registration form at the third party web site that the user is a registered user of the registrar web site, at least “instructions to detect, based on the plurality of submitted fields of the first account application, that there is an indication that the customer is an existing account holder,” as recited in claim 1.

B. Klug Does Not Teach or Suggest Using Instructions to Transmit a Second Account Application with Fewer Fields Based on the Detection that the Customer is an Existing Account Holder

Also, claim 1 recites, in part, “instructions to transmit a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application.”

The Examiner, on page 9 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 7, line 64 through column 8 line 3 of Klug. This referenced portion of Klug discloses a system in which the user, “when entering web site registration information into the fill-out forms to be submitted to [the] registrar,” where “the user determines whether to supply basic information ... or to supply expanded information,” (See Klug, col. 7 ll. 62-67). As disclosed in this section of Klug, the user decides how much registration information to release to the registrar web site, and as stated above, the registrar web site registration is done prior to a third party web site registration, and hence would be considered the first, or initial registration application. Also, on page 9 of the Office action the Examiner states, “[t]herefore, basic information, is provided that has fewer forms compared to the expanded form.” Even if this statement is true, to which applicants do not acquiesce, the decision on which form to fill out is made by the user.

Therefore, Applicants assert that Klug does not teach or suggest, based on the disclosure in Klug that a user decides to provide either basic information or expanded

information to a first application, at least “instructions to transmit a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application,” as recited in claim 1.

C. Bari Does Not Cure The Deficiencies of Klug

Furthermore, Bari does not overcome the deficiencies of Klug. On page 12 of the Office Action the Examiner states, to which Applicants do not acquiesce, that Bari “teaches accounts,” in which the “inventive system enables a user to register with the system by creating an account.” Thus, Bari is not used to teach or suggest, nor does it teach or suggest, at least the above-recited distinguishing features of claim 1. Therefore, Bari does not cure the deficiencies of Klug, noted above, and the applied references cannot be used to establish a prima facie case of obviousness for pending claim 1.

Claims 20 and 23

A. Klug Does Not Teach or Suggest Detecting, on the First Application, an Indication that the Customer is an Existing Account Holder

Claims 20 and 23 recite features that distinguish over the applied references. For example, claims 20 and 23 recite, in part, “detecting that there is an indication that the customer is an existing account holder based on a selection of the selectable indicator associated with the first account application.”

The Examiner, on pages 16 and 21 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 9, lines 14-28 of Klug. As discussed above with respect to similar distinguishing features, recited using

respective language, in claim 1, this portion of Klug discloses a system whereby “***after registering*** at the registrar web site 100, in step 432, the user is automatically placed in contact with the present third party web so that ***he/she submits a registration fill-out form*** to this third party web site 116: (a) indicating that the user’s registration information may be obtained from the registrar web site 100; and (b) providing a user ID (and optionally a password) for the registrar web site 100 to be used as identification at the present third party web site.” (See Klug, col. 9, ll. 14-22)(emphasis added).

For the same reasoning as stated above with respect to similar distinguishing features, recited using respective language, in claim 1, Applicants assert that Klug does not teach or suggest, based on the disclosure in Klug regarding the indication on the second registration form by the user, at least “detecting that there is an indication that the customer is an existing account holder based on a selection of the selectable indicator associated with the first account application,” as recited in claims 20 and 23.

B. Klug Does Not Teach or Suggest Transmitting a Second Account Application with Fewer Fields Based on the Detection that the Customer is an Existing Account Holder

Also, claims 20 and 23 recite, in part, “transmitting a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application.” The Examiner, on pages 17 and 21 of the Office Action, states, to which Applicants do not acquiesce, that this feature is disclosed in column 7, line 64 through column 8 line 3 of Klug. As discussed above with respect to

similar distinguishing features, recited using respective language, in claim 1, this portion of Klug discloses a system in which the user, “when entering web site registration information into the fill-out forms to be submitted to [the] registrar,” where “the user determines whether to supply basic information ... or to supply expanded information,” (See Klug, col. 7 ll. 62-67). For the same reasoning stated above, with respect to similar distinguishing features, recited using respective language, in claim 1, Applicants assert that Klug does not teach or suggest, based on the disclosure in Klug regarding that the user decides to provide either basic information or expanded information to a first application is not, at least “transmitting a second account application to the customer, based on successful detection that there is an indication that the customer is an existing account holder, the second account application including a fewer number of the fields for entering the personal identification and financial information than the first account application,” as recited in claims 20 and 23.

C. Bari Does Not Cure The Deficiencies of Klug

Furthermore, Bari does not overcome the deficiencies of Klug. On pages 18 and 23 of the Office Action the Examiner states, to which Applicants do not acquiesce, that Bari “teaches accounts,” in which the “if the user is ‘browsing’ online, the present invention detects when the user is being asked to enter Authentication credentials,” and “how the inventive system enables a user to register with the system by creating an account.” Thus, Bari is not used to teach or suggest, nor does it teach or suggest, at least the above-recited distinguishing features of claims 20 and 23. Therefore, Bari does not cure the deficiencies of Klug, noted above, and the applied references cannot be used to establish a prima facie case of obviousness for pending claims 20 and 23.

Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1, 20, and 23, and find these claims allowable over the applied references. Also, at least based on their respective dependencies to claims 1 and 20, claims 2-15, 18, 19, 21, and 22 should be found allowable over the applied references, as well as for their additional distinguishing features.

Claim 16

In the Office Action the Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Klug in view of Bari, and in further view of the Official Notice. Applicants respectfully traverse this rejection.

Claim 16, which ultimately depends from independent claim 1, is also patentable over the applied references for reasons similar to those set forth above with respect to claim 1, and further in view of their own respective distinguishing features.

Also, Applicants respectfully assert that the Examiner has inappropriately taken “Official Notice” because according to the M.P.E.P. at Section 2144.03(A) (emphasis added):

Official notice without documentary evidence to support an examiner’s conclusion is permissible only in some circumstances. While “official notice” may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known.***

In this same Section, the M.P.E.P. then provides some examples of when “official notice” was deemed appropriate:

In *Ahlert*, the court held that the Board properly took judicial notice that “it is old to adjust intensity of a flame in accordance with the heat requirement.” See also *In re Fox*, 471 F.2d 1405, 1407, 176 USPQ 340, 341 (CCPA 1973) (the court took “judicial notice of the fact that tape recorders commonly erase tape automatically when new ‘audio information’ is recorded on a tape which already has a recording on it”). In appropriate circumstances, it might not be unreasonable to take official notice of the fact that it is desirable to make something faster, cheaper, better, or stronger without the specific support of documentary evidence.

Applicants assert that the features recited in the claim do not fit within one of the narrow exceptions noted by this Section of the M.P.E.P. This Section of the M.P.E.P. also states “[i]t is never appropriate to rely solely on ‘common knowledge’ in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697.” Applicants therefore assert that it was inappropriate for the Examiner to take “Official Notice” of without providing documentary evidence.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

Jason D. Eisenberg
Attorney for Applicants
Registration No. 43,447

Date: 12/29/08
1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

889440_1.DOC